UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,868	10/24/2003	Caglar Gunyakti	MSFT-2822/305442.1	2074

41505   7590   01/12/2009
WOODCOCK WASHBURN LLP (MICROSOFT CORPORATION)
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

EXAMINER
MURDOUGH, JOSHUA A

ART UNIT	PAPER NUMBER
3621	

MAIL DATE	DELIVERY MODE
01/12/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 October 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Acknowledgements

1.   This action is responsive to Applicants' amendments received on 29 October 2008.

2.   Claims 1-25 are pending and have been examined.

Specification

3.   The specification is objected to as failing to provide proper antecedent basis for the
claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the
following is required:

      a.   "licensing component" in at least claim 1;

      b.   "right-consumption component" in at least claim 1;

      c.   "information-retrieval component" in at least claim 1;

      d.   "callable interface" in at least claim 1;

      e.   "handle-opening component" in at least claim 2;

      f.   "asynchronous-context-initiator component" in at least claim 4; and

      g.   "class of machines" in at least claim 7.

4.   The Examiner recognizes that some of these elements were present in the original claims
and therefore were part of the original disclosure. However, the Examiner cautions Applicants
that great care should be used when including these elements into the specification to avoid the
addition of new matter. To help avoid new matter issues, reference to the original supporting
disclosure should be noted in Applicants' response.

Claim Rejections - 35 USC § 112 1ˢᵗ Paragraph

5.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6.   Claims 1-5 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with

the enablement requirement. There is only a single means in these claims (a processor). "A

single means claim, i.e., where a means recitation does not appear in combination with another

recited element of means, is subject to an undue breadth rejection under 35 U.S.C. §112, first

paragraph" (MPEP 2164.08(a)). There is a lack of enablement because "the claim covers every

conceivable structure (means) for achieving the stated property (result) while the specification

discloses at most only those known to the inventor" (*Id.*).

Claim Rejections - 35 USC § 112 2ⁿᵈ Paragraph

7.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8.   Claims 1-7 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

9.   Claim 1 recites, "the processor comprising: a licensing component…a right-consumption

component…and an information-retrieval component." One of ordinary skill in the art would

not understand if these components are actually circuits within the processor or if they were

intended to be software executed by the processor as is suggested in paragraph [0019] of

Applicants' disclosure. The Examiner has interpreted the latter to be the case when applying the

prior art. If the former was the intention, the Examiner requests that Applicants' state this in

their response and show where in the original disclosure support can be found in order to avoid a

35 U.S.C. 112 1st Paragraph rejection for new matter.

Claim Rejections - 35 USC § 101

10.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

11.   Claims 8-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed

to non-statutory subject matter.

12.   Based on Supreme Court precedent[1] and recent Federal Circuit decisions[2], a § 101

process must (1) be tied to a particular machine or apparatus or (2) transform underlying subject

matter (such as an article or materials) to a different state or thing.[3] If neither of these

requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. §

101.

13.   In this particular case, condition (1) is not met because there is no particular device or

apparatus claimed that performs the process or method steps recited; and condition (2) is not met

because there is no article or material being transformed by the method or process claimed. The

---

[1] *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v.*
Benson, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).
[2] *In re Bilski*, 88 USPQ2d 1385, 1391 (2008); *In re Comiskey*, 84 USPQ2d 1670, 1678 (2007).
[3] The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with
technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

Applicant(s) are encouraged to amend the claims to positively identify the device(s) or apparatus performing the method steps in order to have this rejection withdrawn.

14.   Furthermore, in regards to condition (1), Applicants have clearly stated that they do not intend for the invention to be tied to a particular machine or apparatus. "The computing system environment 100 is only one example of a suitable computing environment and is not intended to suggest any limitation as to the scope of use or functionality of the invention. Neither should the computing environment 100 be interpreted as having any dependency or requirement relating to any one or combination of components illustrated in the exemplary operating environment 100" (Specification, [0017]). "The invention is operational with numerous other general purpose or special purpose computing system environments or configurations. Examples of well known computing systems, environments, and/or configurations that may be suitable for use with the invention include, but are not limited to, personal computers, server computers, hand-held or laptop devices, multiprocessor systems, microprocessor-based systems, set top boxes, programmable consumer electronics, network PCs, minicomputers, mainframe computers, embedded systems, distributed computing environments that include any of the above systems or devices, and the like" (Specification, [0018]). Therefore, the Examiner's position is that these claims are in no way tied to a machine or device, nor were they intended to be.

Claim Rejections - 35 USC § 102

15.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

16.   Claims 1-25, as understood by the Examiner, are rejected under 35 U.S.C. §102(e) as

being anticipated by Rabin (US 6,697,948).

17.   As to claim 1, Rabin shows:

h.   A system comprising:

i.   a processor **201** configured to support the enforcement of a license for a computer

program subject to use under a plurality of licenses (tags **120**) each permitting different

rights in the computer program (C 2, LL 60-65), the processor comprising:

j.   a licensing component **209** common to the plurality of licenses for the computer

program, the licensing component maintains a license store **210** in which the licenses are

stored, the licensing component further maintains a trust store **126** in which dynamic data

is stored in a tamper-resistant manner (C 60, LL 17-33), wherein the dynamic data is

utilizable to validate the licenses (Id.), each license comprising at least one right (access)

in the computer program and a set of data associated with said at least one right (Access

Times, Figure 14), the licensing component exposing a callable interface to the computer

program, said callable interface (API, C 39, LL 43-60) comprising:

k.   a right-consumption component which receives an identifier of a right from the

computer program and determines whether the right can be exercised (C 5, LL 36-53);

and

l.   an information-retrieval component **200** which receives an identifier of said right

from the computer program ("TAG_INST_SW1," Figure 6) and provides said set of data,

or information based on said set of data, to the computer program (Id.).

18.   As to claims 8 and 16, Rabin shows:

m.   A method of restricting the use of a computer program associated with a plurality

of licenses (tags **120**), each license specifying at least one right in the computer program

(C 2, LL 60-65)**111**, the method comprising:

n.   invoking a licensing service **209** common to the plurality of licenses by making a

first call to a first method of an interface (API, C 39, LL 43-60) of said licensing service,

the licensing service in communication with a trust store **126** in which dynamic data is

stored in a tamper-resistant manner (C 60, LL 17-33), wherein the dynamic data is

utilizable to validate licenses (Id.), said first call being parameterized by an identifier

(Fingerprint) associated with a right (access);

in response to said first call receiving an indication as to whether the right is exercisable

(C 5, LL 36-53); and

o.   engaging in either a first behavior or a second behavior according to the

indication (Steps 274-276, Figure 8).

19.   As to claims 2 and 23, Rabin further shows:

p.   said licensing component is common to and usable by a plurality of different

computer programs and said license store stores licenses for the plurality of different

computer programs, the computer program being included among said plurality of

different computer programs, wherein said callable interface further comprises:

q.   a handle-opening component that provides a handle to the computer program

(API allows for the use of handles);

r.   wherein the rights-consumption component receives the handle from the

computer program and uses the handle to identify the computer program from which a

call to the rights-consumption component is received (C 10, LL 31-44); and

s.   wherein the computer program **111** and licensing component **209** are located on a

single computing device **104** (Figure 4).

20.   As to claims 3 and 20, Rabin further shows:

t.   the rights-consumption component causes the licensing component to select a

license based on one or more factors comprising:

u.   whether the license store is associated with the computer program (the tag in the

license store identifies the software, C 10, LL 31-44); and

v.   a conflict rule that determines which license to select from among a plurality of

licenses that are associated with the computer program (Table 1,

"Policy(TAG_INST_SW) or USAGE SUPERVISION POLICY", C 29, LL 29-38).

21.   As to claim 4, Rabin further shows:

w.   the licensing component does not enforce licensing constraints on the computer

program (the guardian center enforces licensing constraints **103**), and wherein said

callable interface further comprises:

x.   an asynchronous-context-initiator (supervising program) component that

establishes a context for asynchronous processing and provides an identifier of said

context to the computer program (guardian center **103** is called, and therefore is

asynchronously called by the supervising program, Figure 12);

y.   wherein said rights-consumption component receives the identifier (fingerprint) of

said context from said computer program and processes a right-consumption request

asynchronously in response to receipt of the identifier of said context (Figure 11).

22.   As to claims 5 and 17, Rabin further shows:

the rights-consumption component determines whether the right can be exercised

based on whether the right is identified in a license (Figure 8).

23.   As to claim 6, Rabin further shows:

the computer program **111** and the licensing component **209** execute on a machine

104 (Figure 4), and wherein the rights-consumption component determines whether the

right can be exercised based on whether the license is bound to said machine (tagging

binds it to the machine).

24.   As to claims 7 and 19, Rabin further shows:

the computer program is associated with a product identifier (fingerprint), and

wherein the rights-consumption component determines whether the right can be exercised

based on whether the license is bound to said machine (Figure 5) or to a class of

machines of which said machine is a member.

25.   As to claim 9, Rabin further shows:

said first behavior comprises allowing the computer program to execute (Step

275, Figure 8), and wherein said second behavior comprises discontinuing execution of

the computer program (Step 276, Figure 8).

26.   As to claim 10, Rabin further shows:

said first behavior comprises allowing the computer program to perform a first set

of functions (normal operation), and wherein said second behavior comprises allowing

the computer program to perform a second set of functions that is non-identical to said

first set of functions (renew/continue license, C 59, LL 38-57).

27.   As to claims 11, 18, and 25, Rabin further shows:

z.   the right is associated with a set of data (Figure 14), wherein the method further

comprises:

aa.   making a second call to a second method of said interface (Step 272, Figure 8),

said second method being parameterized by an indication of the right (call-up if right is

not indicated); and

bb.   in response to said second call, receiving said set of data (Step 277, Figure 8).

28.   As to claim 12, Rabin further shows:

directing the operation of the computer program based on said set of data (Step

272, Figure 8).

29.   As to claim 13, Rabin further shows:

cc.   making a second call to a second method of said interface (Step 272, Figure 8);

and

dd.   in response to said second call, receiving a handle (Through API);

ee.   wherein said second call is made prior to said first call (Figure 8), and wherein

said first call is further parameterized by said handle (Id.).

30.   As to claims 14 and 24, Rabin further shows:

ff.   making a second call to a second method of said interface (Step 272, Figure 8);

and

gg.   in response to said second call, receiving an asynchronous context (call-up);

hh.   wherein said second call is made prior to said first call (Figure 8), wherein said

first call is further parameterized by said asynchronous context (it's a call not a scheduled

event), and wherein the computer program performs at least one action (allow or deny,

Steps 275-276, Figure 8) while the first call is handled asynchronously.

31.   As to claims 15, 21, 22, Rabin further shows:

ii.   said first method determines whether the right is exercisable based on one or more

factors comprising:

jj.   whether the license is bound to a machine or environment on which the computer

program is executing;

kk.   whether the license or right is bound to a product identifier (fingerprint)

associated with the computer program **111**;

ll.   whether the license or right has expired (C 59, LL 38-57); and

mm.   whether the right has been consumed a number of times in excess of a right

specified in the license (Access Times, Figure 14).

Claim Rejections - 35 USC § 103

32.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

33.   Claims 1-25 are alternately rejected under 35 U.S.C. §103(a) as being unpatentable over

Rabin in view of Official Notice.

34.   The Examiner's primary position is that the use of handles is inherent to the API.

However if not inherent, the Examiner takes Official Notice that the use of handles to identify

and run programs is notoriously old and well known in the art because they allow for easier

memory management as only the handle needs to be in a fixed location instead of the whole

program. Therefore, it would have been obvious to one of ordinary skill in the art at the time of

the invention to have modified the teachings of Rabin to use handles when identifying and

running the software as the use of handles allows for more efficient memory usage because the

software does not have to be statically stored.

Claim Interpretations

35.   Use of the word "or" has been interpreted as being disjunctive. Therefore, presence of

either of the elements is sufficient to anticipate, infringe, or render obvious the claim. For

example, claim 8 recites "engaging in either a first behavior or a second behavior according to

the indication." While the Examiner may have cited passages for both alternatives, only one is

considered sufficient to anticipate or render obvious the particular claim.

Response to Arguments

36.   Applicant's arguments with respect to claims 1-25 have been considered but are moot in

view of the new ground(s) of rejection.

Conclusion

37.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

38.   A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R.

§1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

will the statutory period for reply expire later than SIX MONTHS from the date of this final

action.

39.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-

3270. The examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

40.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

41.   Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joshua Murdough
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621